

REMARKS

Claims 1-24 were originally presented and subject to a restriction requirement. Specifically, the action asserts that the application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: a toy gun for launching a foam projectile and having a resilient actuating paddle wheel; and

Species B: a toy gun for launching a foam projectile and having a paddle wheel with a plurality of resilient actuating paddles.

See the Action at p. 2. The action does not identify which claims are directed to each of the allegedly patentably distinct species. The restriction requirement is traversed, and reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the following remarks.

I. The Restriction Requirement Is Traversed

A. The Restriction

As bases for the restriction, the Office action alleges in conclusory fashion that the two groups of invention are distinct from one another, as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: Species A directed to a toy gun for launching a foam projectile and having a resilient actuating paddle wheel; Species B directed to a toy gun for launching a foam projectile and having a paddle wheel with a plurality of resilient actuating paddles.

Action at p. 2. The Office action does not provide reasons and/or examples to support the conclusion that the identified species are patentably distinct, but the Office action further states that “[c]urrently, no claims are generic.” *Id.*

B. The Office Action Does Not Provide Reasons and/or Examples to Support the Conclusion that the Identified Species are Patentably Distinct Species

For a restriction to be proper, the requirement for restriction must provide reasons and/or examples to support the conclusions. *See* M.P.E.P. § 803 (8th Ed., rev. 3, Aug. 2005). The restriction requirement is traversed because there is no demonstration that both applicable criteria for distinctness among the species are present. The requirement only states that the identified species are distinct. Absent the required support for the conclusion that distinctness among the species and the claims exists, applicants respectfully request withdrawal of the requirement for restriction.

C. Search and Examination of the Entire Application Can Be Made Without Serious Burden on the Examiner

According to the M.P.E.P., for restriction to be proper, search and examination of the entire application must impose a serious burden on the examiner. *See* M.P.E.P. § 803 (8th Ed., rev. 3, Aug. 2005) (“If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”). The restriction requirement is traversed because there is no evidence that search and examination of the entire application would impose a serious burden on the PTO.

A serious burden on the examiner may be shown by an appropriate explanation of separate classification, separate status in the art, or a different field of search, among other reasons, but the Office action provides no explanation whatsoever of any burden on the examiner necessitating restriction of the claims. Indeed, the Office action does not even allege that there would be a serious burden. The identified species are concerned with the same subject matter. Without further explanation in the Office action, the applicants fail to see how a resilient actuating paddle wheel is different at all, let alone patentably distinct, from a paddle wheel with a plurality of resilient actuating paddles. Moreover and contrary to the assertion in the Office action, at least independent claims 1, 17, 23 and 24 are generic with respect to Species A and B. Accordingly, a complete search directed to the subject

matter of Species A or B includes a search directed to the subject matter of the other of these Species.

Because search and examination of the entire application can be made without serious burden on the PTO, it would be wasteful of the time, effort, and resources of both the applicants and the PTO to separate the currently-pending claims in an as yet unidentified manner and to prosecute the separated claims in separate applications. Furthermore, if the restriction requirement is maintained, the applicants will likely incur additional prosecution costs associated with filing one or more divisional applications, and the PTO will be required to perform duplicative searches. Thus, withdrawal of the restriction requirement will actually *reduce* the burden on the PTO and on the applicants.

D. Admissions Concerning the Patentability of the Claims Result if the PTO Maintains the Restriction Requirement

If the restriction requirement is maintained, then the U.S. Patent and Trademark Office (“PTO”) admits that each identified species is patentable over the other species. *See, e.g.*, M.P.E.P. § 802.01 (8th Ed., rev. 3, Aug. 2005). These admissions are necessary to the PTO’s entry of the restriction requirement and may be relied upon by the applicants during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

The restriction requirement also should be withdrawn because the restriction may present potential double patenting. According to the M.P.E.P., the patent statute (e.g., 35 U.S.C. § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such

cases imposes a *heavy burden* on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

See M.P.E.P. § 804.01 (8th Ed., rev. 3, Aug. 2005) (emphasis added). The applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

In view of the foregoing, the applicants respectfully request reconsideration and withdrawal of the restriction requirement.

II. Provisional Election

Pursuant to the requirements of 37 C.F.R. § 1.143, the applicants hereby elect the subject matter recited in claims 1-24 (Species B) for further prosecution. Should the Examiner disagree that each of the pending claims reads on the subject matter identified in the Office action as Species B, applicants respectfully request that the Examiner either contact the undersigned directly or provide an explanation of the reasons why any of the pending claims do not read on the subject matter of Species B.

III. Conclusion

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is urged to contact the undersigned attorney.

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Respectfully submitted,

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